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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,659	10/22/2001	Otto J. Prohaska	03141-P0380A WWW/DC	4969
24126	7590	08/25/2006		
ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			EXAMINER OLSEN, KAJ K	
			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/029,659	Applicant(s) PROHASKA ET AL.	
	Examiner Kaj K. Olsen	Art Unit 1753	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 20, 21 and 23-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached discussion.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In view of the applicant's amendment to the claims, the examiner would withdraw the outstanding 112 1st and 2nd paragraph rejections. However, the examiner would maintain the art rejections of claims 20, 21, 23-32 as set forth in the previous office action.

Response to Arguments

2. Applicant's arguments filed 8-8-2006 have been fully considered but they are not persuasive. Applicant continues to traverse the examiner's usage of Debe and Lawrance for their teaching of the use of dry membranes. With respect to Debe, applicant urges that the pretreatment that Debe states can be dispensed with if so desired at col. 25, ll. 20-43 refers to a second pretreatment process. Debe had an earlier pretreatment process at col. 23, ll. 1-10 that is not disclosed as being dispensable. However, even after this pretreatment process by Debe, the Nafion is dried (col. 23, l. 5) and that the membrane is kept dry during the assembly (col. 25, ll. 23-25) The claims now only require the ionomer membrane to be dry during an assembly of the electrode and substrate to the membrane. Hence, if Debe has earlier equilibrated the membrane, dried it, and then assembled its membrane electrode assembly (MEA) while the membrane remains dry (as col. 25, ll. 20-43 urges), then it would read on the claim requirements for when the membrane is to be dry during the assembly of the membrane and electrode as required by the claims.

3. With respect to Lawrance, applicant urges that Lawrance doesn't have the step of having the membrane be dry during the step of providing the at least one opening because Lawrance did

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not have an opening. Applicant appears to be missing the larger point concerning the use of Lawrance. First, EP '041 already taught the provision of the one opening for the sensor. What Lawrance is being utilized is to show that during the assembly of ionomer membrane devices, the membrane need not be wetted until after the final ionomer membrane product is constructed. In Lawrance, the final product of its assembly is an MEA. In EP '041, the final product of the assembly is a sensor having all the method limitations of the claims. Hence, if Lawrance teaches that the membrane can be kept dry during the entire construction of the ionomer membrane containing product (i.e. an MEA) and gives motivation for doing so, one possessing ordinary skill in the art would recognize that other ionomer membrane containing devices could also benefit from keeping the membrane dry.

4. Moreover, even if Lawrance were interpreted in a narrower manner to only motivate one to keep the membrane dry while the membrane was fastened to the electrodes, it is noted that in EP '041 the fastening of the membrane to the electrode would be the last step in the assembly process. Note that fig. 4 and paragraph 0033 show that the electrodes are first placed onto the substrate itself having an opening on it and only then is the ionomer membrane deposited onto the electrodes. Hence, if EP '041 did not wet the membrane until after the ionomer membrane was attached to the electrodes (as Lawrance clearly suggests), then the membrane of EP '041 would have been dry during the provision of the opening, the provision of the electrode proximate to the opening, and while the ionomer membrane is contacted to the electrodes as the claims require.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AU 1753
August 22, 2006



KAJ K. OLSEN
PRIMARY EXAMINER